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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/909,423	07/19/2001	Craig Novak	394-137	7272

7590 09/05/2003

Gerard F. Dunne  
156 Fifth Avenue Suite 1223  
New York, NY 10010

EXAMINER
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STERLING, AMY JO

ART UNIT	PAPER NUMBER
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3632

DATE MAILED: 09/05/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/909,423

Applicant(s)

NOVAK ET AL.

Examiner

Amy J. Sterling

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 07 August 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-3,8,9,14,17-20 and 22-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-3,8,9 and 14 is/are allowed.
- 6) ☒ Claim(s) 17,18 and 20 is/are rejected.
- 7) ☒ Claim(s) 19 and 22-24 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 July 2001 is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

This is a non-final Office Action for application number 09/909,423  
Decorative Gift Bag Balloon Holder, filed on 7/19/01. Claims 1-3, 8, 9, 14, 17-20, 22-24  
are pending. This non-final Office Action is in response to applicant's reply dated  
8/7/03, paper no. 18. The text of those sections of Title 35, U.S. Code not included in  
this action can be found in a prior Office action.

#### ***Claim Rejections - 35 USC § 102***

Claim 17 is rejected under 35 U.S.C. 102(b) as being anticipated by United  
States Patent No. 5441348 to Valentino.

The patent to Valentino discloses a decorative bag having a core (16) formed of  
a weighty material adapted to hold one or more buoyant balloon in place and positioned  
within the decorative bag, and decorative material (20) secured within the decorative  
bag via the core in a position to conceal the core from casual view.

#### ***Claim Rejections - 35 USC § 103***

Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over United  
States Patent No. 5441348 to Valentino and in view of United States Patent No.  
4930903 to Mahoney.

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Valentino shows the basic inventive concept with the exception that it does not teach wherein the core is secured to the interior of the bag.

Mahoney shows a core (14, 48) which is secured to the inside of the interior of a decorative gift bag, used so that the core does not fall out of the bag when moved or tipped. (See Col. 2, lines 46-50). Therefore, it would have been obvious to someone skilled in the art to have modified the core of Valentino to be secured to the bag, in order to make the device less likely to come apart upon moving or tipping the device.

Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over United States Patent No. 5441348 to Valentino and in view of United States Patent No. 5016848 to Metz.

Valentino shows the basic inventive concept with the exception that it does not teach wherein the core has sidewalls generally trapezoidal in shape to taper towards the upper portion.

Metz shows a balloon holding device (10) which has a core (11, 12) for weighting the balloons to a desired surface, the core (11, 12) having a generally trapezoidal shape which tapers towards the upper portion, used so that more balloons can be attached to the device and it will still sufficiently weight the device to the desired surface. Therefore, it would have been obvious to someone skilled in the art to have changed the shape of the core as taught by Valentino, in order to be able to hold more balloons to the desired surface.

***Response to Arguments***

The applicant has argued that the claim 17 is allowable because as amended the Valentino reference does not teach the limitations of the core being a mass of dense material providing sufficient weight to hold a plurality of buoyant balloons. This is unpersuasive because "dense" and the "weight of a plurality of buoyant balloons" are relative terms, with infinite embodiment possibilities. For example, air could be considered a dense mass, as compared to a mass of helium, or a cardboard core could be considered dense in comparison with the air mass. A plurality of buoyant balloons has the same subjective definition, a cardboard core may be weighty enough to hold one or two large balloons or several smaller balloons. Therefore the claim as amended is not patentable over the art cited.

***Allowable Subject Matter***

Claims 19, 22-24 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claims 1-3, 8, 9 and 14 are allowed. The reason is that the prior art does not show a decorative balloon holder having the handles extending from the upper portion of the bag which are secured together. Also the prior art does not show where the core is formed of a compressed sand held by adhesive or a sand, cement and water mixture.

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The reference to Metz shows the balloon holder (10) being filled with loose sand or ballast.

***Conclusion***

The following documents are not relied upon are considered pertinent to the applicants disclosure

6523798 to Novak

5755419 to Gearheart et al.

Any inquiry concerning this communication should be directed to Amy J. Sterling at telephone number 703-308-3271. The examiner can normally be reached (M-F 8 a.m.-5:00 p.m.). If attempts to reach the examiner are unsuccessful, the examiner's supervisor, Leslie Braun can be reached at 703-308-2156. The fax machine number for the Technology center is 703-305-3597 or 703-305-3598 (formal amendments) or 703-308-3519 (informal amendments/communications).

Any inquiry of a general nature or relating to the status of this application should be directed to the Technology Center receptionist at 703-308-2168.



AJS  
Amy J. Sterling  
8/28/03



LESLIE A. BRAUN  
SUPERVISORY PATENT EXAMINER